



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,952	09/26/2001	Toshihide Hida	1122.65856	1582

EXAMINER	
VAN DOREN, BETH	

ART UNIT	PAPER NUMBER
3623	

MAIL DATE	DELIVERY MODE
11/16/2007	PAPER

7590 11/16/2007
Patrick G. Burns, Esq.
GREER, BURNS & CRAIN, LTD.
Suite 2500
300 South Wacker Dr.
Chicago, IL 60606

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/963,952	Applicant(s) HIDA, TOSHIHIDE	
	Examiner Beth Van Doren	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9, 13-15, 19-21 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9, 13-15, 19-21 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is Final office action in response to communications received 08/27/2007. Claims 7, 13, and 19 have been amended. Claims 7-9, 13-15, 19-21, and 25-27 are now pending in this application.

Response to Arguments

2. Applicant's arguments with respect to Bilbrey et al. (U.S. 2002/0103932) have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7-9, 13-15, 19-21, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilbrey et al. (U.S. 2002/0103932).

As per claim 7, Bilbrey et al. teaches a computer readable medium storing a program to cause a computer to perform message-address management processing in a system capable of exchanging messages among a plurality of servers and clients, wherein the program causes a server computer to perform:

when a message address of a member of a message exchanging group is changed, absence response information including at least an old address and a new address of the member

is caused to be received from the client (See paragraph 83, where updates of a recipient's address is provided. See also paragraphs 7-8, 10, 46-7, and 63-4, where a member of a group of recipients in a message system changes his/her address and this information is sent by the client to the server. See also figures 20-21, where a recipient specifies his old and new address as well as with whom this information can be shared);

determining, from a plurality of provided message address lists, lists of message exchange groups, a message address list including the old address of the member, and extracting message addresses of the rest of the members of the determined message address list, wherein the rest of the members includes members with message addresses that have not been changed (See paragraphs 58, 80, 85-9, wherein an address list is communicated and used to substantially update the "sponsors" email address list. Email addresses are received and matched against old email addresses. The members that are not the member whose address is changing are obtained and the member along with other members in the list with old addresses are obtained, and updated. See also paragraphs 55, 61, 63-4, 68);

determining a server associated with each of the rest of the members of the determined message list (See abstract, paragraphs 7, 82, 112, wherein members are associated with a server which is located for address changes and notifications. See also paragraphs 8, 10, 46-7, 55, 59, and 85-9, where the network server has information concerning addresses and the "sponsor" interacts with this server based on the information contained in its list);

specifying a server to which the absence response information is to be provided, on the basis of the determined server or servers (See paragraphs 7-8, 10, 46-7, 55, 59, and 85-9, where

the network server has information concerning address changes, and the "sponsor" interacts with this server based on the information contained in its list); and

distributing the absence response information to the specified server or servers (See paragraphs 7, 55, 59, wherein the network server and the sponsor communicate to provide and receive the information).

However, Bilbrey et al. does not expressly disclose determining domain information associated with each of the rest of the members of the determined message list or specifying a server based on the domain information.

Bilbrey et al. discloses a system that allows email addresses to be updated. Examiner takes official notice that domain information consists of a set of network addresses and is a name with which name server records are associated and through which resources are accessed at a number of different servers in the network. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to determine domain information when determining server information associated with members in order to more efficiently locate members in the network using addresses.

As per claim 8, Bilbrey et al. discloses wherein the absence response information contains a period of validity of the absence response information (See paragraphs 112 and Table 3, where the determination is made as to whether addresses are valid. See also paragraphs 61 and 68, wherein the address information is time stamped, to show the time at which the date become valid and up to date).

As per claim 9, Bilbrey et al. teaches wherein a plurality of pieces of the absence response information to be distributed to the same server are gathered together for distribution

See paragraph 58, wherein the information to be distributed to the sponsor is gathered together at the server for distribution to the sponsor based on the list and the Reconnection Manager).

Claims 13-15 recite substantially similar subject matter to claims 7-9, respectively, and are therefore rejected using the same art and rationale set forth above.

Claims 19-21 recite substantially similar subject matter to claims 7-9, respectively, and are therefore rejected using the same art and rationale set forth above.

As per claims 25-27, Bilbrey et al. discloses wherein absence response information includes a flag indicating whether the absence response information is to be provided to a mail server administrator (See paragraph 0080, wherein an indication is sent by an administrator to receive absence information (i.e. undeliverable addresses and/or all addresses)).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Application/Control Number:
09/963,952
Art Unit: 3623

Page 6

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is 571-272-6737. The examiner can normally be reached on M-F, 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

bvd
bvd

November 9, 2007

Beth Van Doren
BETH VAN DOREN
PRIMARY EXAMINER
AU 3623